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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/746,495	12/21/2000	Masaharu Matsumoto	FUJR 18.110	9759
26304	7590	05/03/2005	EXAMINER	
KATTEN MUCHIN ZAVIS ROSENMAN 575 MADISON AVENUE NEW YORK, NY 10022-2585			HOOSAIN, ALLAN	
			ART UNIT	PAPER NUMBER
			2645	

DATE MAILED: 05/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/746,495	MATSUMOTO ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Allan Hoosain	2645	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 March 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-12 is/are allowed.
- 6) ☒ Claim(s) 13-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

*FW*

## **DETAILED ACTION**

### ***Allowable Subject Matter***

1. Claims 1-12 are allowed.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 16 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. For example there does not appear to be a written description of the new limitations 'IP phone' and 'non- IP phone' as filed.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Art Unit: 2645

5. Claims 13-15,17-20 are rejected under 35 U.S.C. 102(e) as being anticipated by **Hutton et al.** (US 6,108,704).

As to Claim 13, with respect to Figures 5-9, **Hutton** teaches a communication terminal equipment, 12, for performing communication control on information indicating whether or not a callee (any third party) is present over a network, comprising:

presence inquiring means for making an inquiry to a receiver communication terminal about a presence state of a callee (communicating party) (Col. 5, lines 55-56);

presence information receiving means for receiving presence information from a receiver communication terminal (Col. 5, lines 60-64);

presence information display means for displaying said received presence information (Col. 8, lines 41-50);

presence determining means for determining said presence state of an operator of said communication terminal equipment (Col. 6, lines 1-5, Col. 8, lines 41-50);

presence information generating means for generating said presence information (Col. 5, lines 25-44); and

presence information sending means for sending said presence information to a caller communication terminal upon reception of said inquiry (Col. 5, lines 60-64).

As to Claims 14,19-20, with respect to Figures 1-2 and 9, **Hutton** teaches a method implemented in a caller communication terminal to indicate presence information associated with a receiver communication terminal comprising:

Art Unit: 2645

(a) transmitting an inquiry querying a receiver communication terminal regarding its presence state (Col. 5, lines 55-56);

(b) receiving said presence state associated with said receiver communication terminal (Col. 5, lines 60-64), said received presence state comprising any of, or a combination of the following:

a result of a check for duration of a screensaver at said received communication terminal,

a check for duration of non-entry of inputs at said receiver communication terminal,

a result of a pressure sensor check indicating load of an operator at said receiver communication terminal, and

a result of a schedule check performed in conjunction with a schedule database (Col. 6, lines 6-16), and

(c) rendering said received presence state of said receiver communication terminal in said caller communication terminal (Col. 5, lines 60-64 and Col. 6, lines 1-5).

As to Claim 15, **Hutton** teaches a method implemented in a caller communication terminal to indicate presence information associated with a receiver communication terminal, as per claim 14, wherein said caller communication terminal and receiver communication terminal are IP telephones communicating over an IP network (Col. 3, lines 5-10).

Art Unit: 2645

As to Claim 17, **Hutton** teaches a method implemented in a caller communication terminal to indicate presence information associated with a receiver communication terminal, as per claim 14, wherein an operator at said receiver communication terminal is absent, said method comprises the additional step of initiating an auto-notification request instructing said receiver communication terminal to transmit a presence notification message when said operator is present (Col. 6, lines 37-48).

As to Claim 18, **Hutton** teaches a method implemented in a caller communication terminal to indicate presence information associated with a receiver communication terminal, as per claim 14, wherein, in a multiline reception mode, said presence state associated with said receiver communication terminal is rendered at a sub-receiver (Col. 9, lines 3-17).

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was

Art Unit: 2645

made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Hutton** in view of **Yacenda et al.** (US 5,822,418).

As to Claim 16, **Hutton** teaches a method implemented in a caller communication terminal to indicate presence information associated with a receiver communication terminal, as per claim 14, wherein said caller communication terminal is a non-IP telephone and said receiver communication telephone is an IP telephone, with said presence information modified as a display message prior to being rendered in said receiver communication terminal (Col. 3, lines 5-10);

**Hutton** does not teach the following limitation:

“a voice message”

However, it is obvious that Hutton suggests the limitation. This is because **Hutton** teaches a caller terminal with display, volume and sound controls (Col. 9, lines 53-56). **Yacenda** teaches a caller terminal which displays or plays audio messages about called parties locations (Col. 14, lines 41-47). Having the cited analogous art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add audio message capability to **Hutton's** invention for informing a caller about the location status of a called party as taught by **Yacenda's** invention in order to provide callers with information on called parties before making connections to the called parties.

***Response to Arguments***

9. Applicant's arguments filed 3/2/05 have been fully considered but they are not persuasive with respect to Claims 13-20 because of the following:

The claims do not recite that the caller terminal communicates 'directly' with the receiver terminal when sending presence requests or receiving presence information. **Hutton** still reads on the claims as indicated in the instant Office Action.

Examiner respectfully invites Applicants to contact Examiner to discuss possible amendments for overcoming the prior art of record.

***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

**Miner et al.** (US 5,652,789) teach a virtual hallway where caller subscribers can find out and see other subscribers on a network.

**Suder et al.** (US 6,842,505) teach spot detectors which detects users presence at users terminals and makes other terminals aware of the users presence.

11. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks  
Washington, D.C. 20231  
**or faxed to:**

(703) 872-9314, (for formal communications intended for entry)

**Or:**

(703) 306-0377 (for customer service assistance)




Art Unit: 2645

Hand-delivered responses should be brought to Carlyle, Alexandria, VA 22313  
(Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Allan Hoosain** whose telephone number is (571) 272-7543. The examiner can normally be reached on Monday to Friday from 8 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Fan Tsang**, can be reached on (571) 272-7547.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-2600.

  
**Allan Hoosain**  
**Primary Examiner**  
**4/21/05**